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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/464,377 12/15/99 STALLCUP

M 13761-726

EXAMINER

HM22/0328

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ART UNIT

PAPER NUMBER

1652

DATE MAILED:

03/28/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/464,377

Applicant(s)

Stallcup et al.

Examiner

Rebecca Prouty

Group Art Unit

1652



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-38 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-38 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1652

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-3, drawn to DNA, vectors and host cells encoding a protein arginine methyltransferase, classified in class 435, subclass 325.
- II. Claims 4-13, drawn to a protein arginine methyltransferase, classified in class 435, subclass 193.
- III. Claims 14-16, drawn to antibodies to protein arginine methyltransferase, classified in class 530, subclass 387.9.
- IV. Claims 17-20, drawn to methods of methylating a polypeptide, classified in class 435, subclass 68.1.
- V. Claim 21, drawn to methylated histone H3, classified in class 530, subclass 358.
- VI. Claim 22, drawn to antibodies to methylated histone H3, classified in class 530, subclass 389.1.
- VII. Claims 23-26, drawn to assays for modulators of CARM1/GRIP-1 binding, classified in class 435, subclass 7.1.
- VIII. Claims 27-32, drawn to methods of modulating expression of a nuclear-receptor dependent gene, classified in class 435, subclass 375.

Art Unit: 1652

IX. Claims 34-38, drawn to methods of screening for modulators of CARM1 coactivator activity, classified in class 435, subclass 6.

The inventions are distinct, each from the other because of the following reasons:

The DNA of Group I, and the proteins of Groups II, III, V and VI, each comprise a chemically unrelated structure capable of separate manufacture, use and effect. The DNA comprises a nucleic acid sequence, and the proteins of Groups II, III, V and VI each comprise unrelated amino acid sequences. The DNA has other utility besides encoding the proteins such as a hybridization probe, the proteins can be made by another method such as isolation from natural sources or chemical synthesis and the proteins have other utility besides acting as an antigen to induce the antibodies such as for the methods of Group IV.

Inventions II and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case the product can be used to induce antibodies.

Art Unit: 1652

Inventions IV and V are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by a materially different method such as chemical synthesis.

The DNA of Group I, the antibody of Group III, and the antibody of Group VI are unrelated to the method of Group IV as they are neither used nor made by the methods of Groups ~~V, VI and VIII.~~ ^{IV}

Inventions ~~VI~~ ^I and VII, VIII or IX are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the DNA of Group ~~VI~~ ^I can be used to produce the proteins of Group ~~II~~.

The proteins of Group II, the antibody of Group III, the histones of Group V and the antibody of Group VI are unrelated to

Art Unit: 1652

the methods of Group VII-IX as they are neither used nor made by the methods of Group VII-IX.

The methods of Groups V-IX are independent as they comprise different steps, utilize different products and produce different results.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rebecca Prouty, Ph.D. whose telephone number is (703) 308-4000. The examiner can normally be reached on Monday-Friday from 8:30 to 4:30.

Art Unit: 1652

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy, can be reached at (703) 308-3804. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

A handwritten signature in cursive script, appearing to read "Rebecca Prouty".

Rebecca Prouty
Primary Examiner
Art Unit 1652